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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,070	10/25/2001	Wanda Green Thompson	RCA 89470	8767
Joseph S Tripoli Thomson Multimedia Licensing Inc PO Box 5312 Princeton, NJ 08543-5312				
7590 03/17/2009			EXAMINER PENG, FRED H	
			ART UNIT 2426	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/018,070

**Applicant(s)**

THOMPSON ET AL.

**Examiner**

FRED PENG

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/08/2009 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to claims 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues on page 6 of Remarks that Macrae fails to teach or suggest the step of "displaying one of the stored advertisements associated with the determined next program before the determined next program has been reached by the highlighted element.

The Examiner respectfully disagrees with applicant's arguments. In one embodiment, Macrae teaches the advertisements in the library are assigned to themes. For example, a particular advertisement for automobile might be assigned to a sport event theme, such that when user selects a sports theme guide (FIG.7) and scroll through the sports theme guide (FIG.8), the automobile advertisement is selected for displaying before the user reaching the next determined program which is also associated with the automobile advertisement (Para 331-332).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 21-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Macrae et al (US 2003/0208756).

Regarding Claims 21 and 27, Macrae discloses a video apparatus with corresponding method for providing an advertisement dynamically along with an electronic program guide (FIG.1) having information of programs in response to movement of a highlighted element in the electronic program guide, the highlighted element being movable within the electronic program guide in response to a user key entry made via a user control device of the video apparatus (Para 197- Para 200), the video apparatus being operative to enable performance of steps comprising:

receiving a plurality of advertisements, each one of the received advertisements being associated with at least one program in the electronic program guide and including a respective descriptor for identifying a program; storing the received advertisements (Para 327);

monitoring the movement of the highlighted element in the electronic program guide; determining a next program in the electronic program guide to be reached by the highlighted element based on the monitoring step (FIG.7, FIG.8; Para 331-Para 332; when a sports theme guide is selected in FIG.7 and scrolling through the sports theme guide in FIG.8); and

displaying one of the stored advertisements associated with the determined next program before the determined next program has been reached by the highlighted element (Para 332 lines 1-14; displaying an automobile advertisement related to a sports related program before reaching the determined next program also associated with sports theme).

Regarding Claims 22 and 28, Macrae further discloses identifying which of the advertisements are targeted advertisements for display during the movement of the highlighted element in the electronic program guide, wherein the displayed advertisement is one of the

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identified targeted advertisements (Para 332; identifying an automobile advertisement when scrolling through the sports theme guide).

Regarding Claims 23 and 29, Macrae further discloses a channel descriptor for a respective one of the advertisements (FIG.8, a channel descriptor such as TNT).

Regarding Claims 24 and 30, Macrae further discloses the displaying step is performed in response to the channel descriptor associated with the displayed advertisement matching a channel associated with the determined next program (the automobile advertisement matching a sports channel associated with the determined next program).

Regarding Claims 25 and 31, Macrae further discloses a time descriptor (FIG.8, programs listed with time information).

Regarding Claims 26 and 32, Macrae further discloses the displaying step is performed in response to the channel descriptor associated with the displayed advertisement matching a channel associated with the determined next program and the time descriptor associated with the displayed advertisement matching a current time (FIG.8; the time descriptor associated with the displayed advertisement such as on golden pond is 8:00 pm matching a current time above 8:00 pm).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:00-18:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

fhp

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2426